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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,230	04/22/2004	Hideyuki Kinoshita	26112	7134
20529	7590	05/03/2007		
NATH & ASSOCIATES 112 South West Street Alexandria, VA 22314			EXAMINER SHEWAREGED, BETELHEM	
			ART UNIT 1774	PAPER NUMBER
			MAIL DATE 05/03/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/829,230	<b>Applicant(s)</b> KINOSHITA ET AL.	
	<b>Examiner</b> Betelhem Shewareged	<b>Art Unit</b> 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some. \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's response filed on 02/12/2007 has been fully considered. Claims 1-8 are pending. (NOTE: Claim 8 is withdrawn from consideration as non-elected invention).
2. Applicant is advised to provide claim 8 with the proper claim status identifier, i.e., the claim should be identified as (withdrawn, previously presented).

### ***Claim Rejections - 35 USC § 102***

3. Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawatsu et al. (US 6,025,286).
4. A stencil sheet comprises a fibrous support and a layer of polyester film (abstract, background art and claim 1). The fibrous support is equivalent to the claimed fiber layer, and the layer of polyester film is equivalent to the claimed layer. A layer of silicone based release agent is coated on the layer of polyester film (col. 8, line 11). The melting point of the layer of polyester film is 230 degree C or lower (col. 3, line 53). The polyester film of Kawatsu has inorganic particles and it is stretched during process of making the stencil; therefore, the polyester film of Kawatsu may comprise pores. With respect to the value of the ratio of storage modulus, basis weight value and air permeability value, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Kawatsu reference teaches all of Applicant's claimed

compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

### ***Claim Rejections - 35 USC § 103***

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawatsu et al. (US 6,025,286).

6. Kawatsu does not expressly disclose a pore size value of the layer of polyester film. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the pore size in order to optimize ink permeability and enhance print quality. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

### ***Response to Arguments***

7. Applicant's argument is based on that the thermoplastic resin of the porous resin layer (porous film) of the presently claimed invention has a melting point of 50 to 150°C, in contrast, the films of Kawatsu have the melting points (T<sub>m1</sub>) over 150°C, e.g., 192 C (Example 1), 198°C (Example 2), 190°C (Example 3), and 191°C (Example 4), thus the

Art Unit: 1774

film of Kawatsu does not possess the claimed G1/G2 property. This argument is not persuasive because the melting point of the resin in the prior art is not limited to the values in the Examples. The melting point is 230 degree C or lower (col. 3, line 53), which includes the claimed value of melting point of 50-150 degree C. Therefore, Kawatsu can possess the claimed G1/G2 property.

8. Applicant further argued that the fact that the film of Kawatsu includes inorganic particles and is stretched does not provide any evidence of the porosity of the film, more specifically the porosity of the present invention that is formed preferably by a different method. This argument is not persuasive because the process by which the pores are formed in the claimed porous layer is not dispositive of the issue of the patentability of the instant article claims. If Applicant believes that the polyester film of Kawatsu does not have pores even if the polyester film includes inorganic particles and is stretched, the Applicant is advised to provide factual evidence showing that there are no pores in the polyester film.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 1774

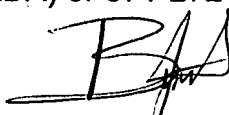
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS  
April 27, 2007.

  
BETELHEM SHEWAREGED  
PRIMARY EXAMINER